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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,765	12/30/1999	ERIC HAMER	KEYNP005	6830

26541            7590            07/09/2003  
RITTER, LANG & KAPLAN  
12930 SARATOGA AE. SUITE D1  
SARATOGA, CA 95070

EXAMINER
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NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/475,765	HAMER ET AL.
	Examiner Phuoc H. Nguyen	Art Unit 2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on April 28, 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 31-37 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-37 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This office action is in response to the applicants Purpose of Declaration filed on April 28, 2003 (Paper No. 11). Claims 1-37 are presented for further consideration and examination.

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

### *Election/Restrictions*

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30 drawn to a system for measuring performance of a transaction over a network, classified in **class 709, subclass 224**.
  - II. Claims 31-37, drawn to a method of recording a transaction, classified in **class 709, subclass 202**.
4. The inventions are distinct, each from the other because of the following reasons:
5. Inventions of Group I is related as combination and subcombinations of Group II. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombinations has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (Group I) as claimed does not require the particulars of the subcombinations (Group II) as claimed because both subcombinations and combination are presented and assumed to be patentable, the omission of specific details of the subcombinations as recited in claims 31-37, in the combination as recited in claims 1-30 is evidence that the

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patentability of the combination does not rely on the details of the specific subcombinations.

The subcombinations of Group II has separate utility such as a method of recording a transaction.

6. Inventions of the Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II have separate utility such as a method of recording a transaction. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and the search required a separate status in the art as shown by their different classification, the search required for one Group is not required for other Group, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Cindy S. Kaplan, Reg. No. 40,043 on July 1, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 31-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142 (b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-30 rejected under 35 U.S.C. 102(e) as being anticipated by Killian U.S. Patent 6,438,592.

12. Referring to claims 1, and 20, Killian reference discloses connecting a data acquisition agent to the network (Fig. 1; and col. 8, lines 7-18); sending a request for information from the data acquisition agent to the information source (col. 8, lines 7-18); loading data responsive to the request for information onto the data acquisition agent (col. 8, lines 7-18); executing the transaction (Abstract; col. 3, lines 47-63); collecting performance measurements for the transaction (Abstract; col. 3, lines 47-63; and col. 17, lines 49-67); and sending the performance measurements to a storage device (col. 9, lines 61 through col. 10, lines 11).

13. Referring to claims 2, and 22, Killian reference discloses the transaction comprises simulating a transaction previously recorded between a user machine and the information source (col. 8, lines 39-56).
14. Referring to claim 3, Killian reference discloses collecting performance measurement comprises collecting download time of the data in response to the request for information (col. 8, lines 39-56; and col. 9, lines 12-35).
15. Referring to claims 5, and 26, Killian reference discloses collecting performance measurements comprises identifying errors occurring during the transaction (Abstract; Figure 19; and col. 22, lines 33-51).
16. Referring to claim 6, Killian reference discloses the network is the Internet (Figure 1, Internet (110)).
17. Referring to claim 7, Killian reference discloses the information source is a web server and the request for information comprises requesting a web page (col. 3, lines 16-32).
18. Referring to claims 8, and 27, Killian reference discloses collecting performance measurements comprises collecting download time for each web page downloaded during the transaction (col. 3, lines 47-63).
19. Referring to claims 9, and 28, Killian reference discloses collecting performance measurements comprises collecting download time for individual components within each of the web pages (Abstract; col. 3, lines 47-63; and col. 9, lines 12-35).
20. Referring to claim 10, Killian reference discloses connecting a data acquisition agent to the network comprises connecting a plurality of data acquisition agents to the network at a plurality of locations (Abstract; col. 3, last paragraph through col. 4, 1<sup>st</sup> paragraph).

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21. Referring to claim 11, Killian reference discloses comprising displaying the performance measurements on a web site (col. 10, lines 18-20).
22. Referring to claim 12, Killian reference discloses executing the transaction comprises sending a query from the data acquisition agent to the information source after the data is loaded (col. 8, lines 39-56; col. 8, last paragraph through col. 9, 1<sup>st</sup> paragraph; and col. 11, lines 32-54).
23. Referring to claim 13, Killian reference discloses executing the transaction comprises submitting an order from the data acquisition agent to the information source after the data is loaded (col. 8, lines 39-56; col. 8, last paragraph through col. 9, 1<sup>st</sup> paragraph; and col. 11, lines 32-54).
24. Referring to claim 14, Killian reference discloses executing the transaction comprises updating state information to link web pages together within a transaction (Figure 20; and col. 4, lines 59-62).
25. Referring to claim 15, Killian reference discloses updating state information comprises searching for a session ID (col. 8, last paragraph through col. 9, 1<sup>st</sup> paragraph; and col. 21, lines 27-54).
26. Referring to claim 16, Killian reference discloses updating state information comprises searching for a text (Figure 8; col. 10, lines 50-65; and col. 13, 2<sup>nd</sup> paragraph).
27. Referring to claim 17, Killian reference discloses updating state information comprises searching for a frame (Figures 10, and 11; col. 16, lines 10-25).
28. Referring to claim 18, Killian reference discloses updating state information comprises searching for a URL (Figure 11; col. 10; lines 50-65; and col. 13, 2<sup>nd</sup> paragraph).

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29. Referring to claim 19, Killian reference discloses updating state information comprises searching for a HTML text (Figure 8; col. 3, lines 47-63; col. 11, 2<sup>nd</sup> paragraph; and col. 13, 2<sup>nd</sup> paragraph).

30. Referring to claim 21, Killian reference discloses the data acquisition agent includes a browser embedded within the agent (col. 3, lines 34-46; col. 8, lines 28-38; col. 13, lines 66 through col. 14, lines 10; and col. 15, 2<sup>nd</sup> paragraph).

31. Referring to claim 23, Killian reference discloses the data acquisition agent is configured to receive said recorded transaction over the network (Figure 1).

32. Referring to claim 24, Killian reference discloses the data acquisition agent is configured to receive instructions specifying a plurality of said recorded transactions to execute (col. 3, lines 34-63; col. 8, lines 39-56; and col. 9, lines 12-35).

33. Referring to claim 25, Killian reference discloses the data acquisition agent is configured to repeat execution of said specified transactions until new instructions are received (col. 12, lines 35-53).

34. Referring claim 29, Killian reference discloses a monitoring device for recording when the agent last executed the transaction (col. 39, lines 54-64; and col. 40, lines 47-51).

35. Referring to claim 30, Killian reference discloses the agent is operable to store the collected performance measurements (col. 8, lines 39-56).

### ***Conclusion***

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Hoyer et al. U.S. Patent 6,381,635**

**Barrick, Jr. et al. U.S. Patent 6,006,260**

**Yee et al. U.S. Patent 5,872,976**

**Forman et al. U.S. Patent 6,178,449**

**Chandra et al. U.S. Patent 6,397,359**

**Chen et al. U.S. Patent 6,327,700**

**Merriam U.S. Patent 6,587,878**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 703-305-5315. The examiner can normally be reached on Mon -Thu ( 7AM-4:30PM ) and off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Phuoc H. Nguyen  
Examiner  
Art Unit 2143

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July 1, 2003

  
**DAVID WILEY**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**